

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of |) | Group Art Unit: 1732 |
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| CHARLES A. BYRNE |) | Examiner: Stefan Staicovici |
| |) | |
| Serial No. 10/701,052 |) | |
| |) | |
| Filed: November 3, 2003 |) | Docket No. MAMMO-44436 |
| |) | |
| For: IMPROVED METHOD FOR |) | |
| MANUFACTURING ANIMAL |) | |
| CHEW TOY |) | |
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RESPONSE

Commissioner for Patents
Via E-File

Dear Sir:

In response to an Office Action dated June 13, 2006, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

Listing of Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application.

1. (Currently Amended) A method for manufacturing an animal chew toy, comprising the steps of:

providing ~~first and second layers~~ at least one sheet of rubber material formed in a general shape and size of the animal chew toy;

placing a floss material comprising a at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy adjacent to between the first and second layers the at least one sheet of rubber material; and

molding the ~~first and second layers~~ sheets of rubber and floss material into the animal chew toy;

wherein the molding step includes the steps of compressing the sheets of rubber and floss material between opposing mold members under pressure and heat.

2. (Canceled)

3. (Original) The method of claim 1, wherein the rubber material comprises a tire rubber material.

4. (Original) The method of claim 3, wherein the tire rubber material comprises natural or synthetic rubber mixed with carbon black.

5. (Original) The method of claim 1, wherein the synthetic fibers of the mesh fabric comprise nylon or polyester fibers.

6. (Canceled)

7. (Original) The method of claim 1, including the step of attaching a rope to the animal chew toy.

8. (Original) The method of claim 1, including the step of retaining an animal treat in a cavity of the animal chew toy.

9. (Original) The method of claim 1, including the step of associating a buoyant insert with the animal chew toy.

10. (Original) The method of claim 9, wherein the associating step comprises the step of inserting the buoyant insert into a cavity of the animal chew toy.

11. (Original) The method of claim 9, wherein the buoyant insert comprises a closed cell foam.

12. (Original) The method of claim 1, including the step of adding a scent material to the first and second layers of rubber.

13. (Original) The method of claim 1, wherein the animal chew toy is of a tire configuration and having a diameter of between six inches and ten inches, and wherein the tire animal chew toy does not include imbedded metal therein.

14. (Original) A method for manufacturing an animal chew toy, comprising the steps of:

providing first and second layers of a tire rubber material cut into a general shape or size of the animal chew toy;

placing a floss material comprising a synthetic fiber mesh cut into the general shape or size of the animal chew toy between the first and second layers of rubber material; and

compressing the first and second layers of rubber and floss material under pressure and heat to mold the first and second layers of rubber and floss material into the animal chew toy.

15. (Original) The method of claim 14, wherein the tire rubber material comprises natural or synthetic rubber mixed with carbon black.

16. (Original) The method of claim 14, wherein the synthetic fibers of the mesh fabric comprise nylon or polyester fibers.

17. (Original) The method of claim 14, including the step of attaching a rope to the animal chew toy.

18. (Original) The method of claim 14, including the step of retaining an animal treat in a cavity of the animal chew toy.

19. (Original) The method of claim 14, including the step of associating a buoyant insert within a cavity of the animal chew toy.

20. (Original) The method of claim 14, including the step of adding a scent to the layers of rubber.

21. (Currently Amended) A method for manufacturing an animal chew toy, comprising the steps of:

providing ~~first and second layers~~ at least one sheet of a tire rubber material comprised of natural or synthetic rubber mixed with carbon black and cut into a general shape or size of the animal chew toy;

placing a sheet of floss material comprising a nylon or polyester fiber mesh cut into the general shape or size of the animal chew toy ~~between the first and second layers adjacent to the at least one sheet~~ of rubber material; and

compressing the first and second layers sheets of rubber and floss material under pressure and heat to mold the first and second layers of rubber and floss material into the animal chew toy.

22. (Original) The method of claim 21, including the step of attaching a rope to the animal chew toy.

23. (Original) The method of claim 21, including the step of retaining an animal treat in a cavity of the animal chew toy.

24. (Original) The method of claim 21, including the step of associating a buoyant foam insert within a cavity of the animal chew toy.

25. (Original) The method of claim 21, including the step of adding a scent material to the layers of rubber.

REMARKS/ARGUMENTS

The present Application has been carefully reviewed in light of the June 13, 2006 Office Action, wherein all pending claims were rejected under 35 U.S.C. §103 under various combinations of references. In response, Applicant has amended Claims 1 and 21, and canceled Claims 2 and 6. Reexamination and reconsideration of the Application, as amended, is respectfully requested.

CLAIM REJECTIONS

Independent Claim 1 has been amended to recite that at least one sheet of rubber material is provided and formed in a general shape and size of the animal chew toy. A floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy is placed adjacent to the at least one sheet of rubber material. The sheets of rubber and floss material are molded into the animal chew toy by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat. Applicant notes that the recitations of canceled claims 2 and 6 have been incorporated into amended independent Claim 1.

Claims 1 and 6 were rejected in Office Action as being unpatentable over Denesuk, et al. (U.S. Patent No. 6,576,246) in view of Kamiura, et al. (U.S. Patent No. 4,605,527). Moreover, Claim 2 is rejected under the combination of Denesuk in view of Kamiura and further in view of Sasson, Jr. (U.S. Patent No. 6,341,771).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing *In re Vaeck*, 20 USPQ 2d 1438 (Fed.Cir. 1991).

The Denesuk reference discloses a degradable animal chewing article comprised of a matrix made of a natural polymer, a synthetic organic polymer or a mixture thereof, a natural or synthetic fibrous material that comprises fibers and that is bonded chemically or physically with the matrix material, and optionally microbe inhibiting agents. As described in column 4, lines 17-23, Denesuk's objective is to provide a safer chewable article for animals by incorporating binding material into the article which increases durability, decreases the tendency for pieces to detach, and inhibit formation of sharp edges upon breakage. Denesuk discloses that the natural synthetic fibrous materials are in the form of fibers of discrete lengths (0.1-1200 μm) rather than continuous filaments (see column 7, lines 27-35). Such short-length fibers are mixed with the other materials to create a matrix.

There is no discussion whatsoever with Denesuk of providing at least one sheet of rubber material formed in a general shape and size of the animal chew toy, and placing a floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy adjacent to the at least one sheet of rubber material and then subsequently compression molding the sheets into the animal chew toy.

Kamiura discloses a process for producing clutch facings. As stated in column 2, lines 50-54, it is an object of Kamiura to provide a process for producing clutch facings exhibiting good performances without the use therein of any asbestos. Kamiura discloses replacing asbestos with an inorganic fiber, such as glass fibers. As disclosed in column 3, lines 40-50, a plurality of inorganic fiber yarns are passed through a vessel containing a solution of thermosetting resin to cause the resin to adhere to the yarns. Sheets of rubber are then brought into contact with the upper and lower sides of the yarns, thus sandwiching the yarns therebetween, and are squeezed between and by a pair of rolls. The clutch facing stock materials are cut so that the yarns are divided

into groups each having 1 to 5 yarns, and these are wound about the central axis portion of a mold for preforming in a winding manner.

Kamiura does not disclose providing at least one sheet of rubber material formed in a general shape and size of the animal chew toy, nor placing a floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy adjacent to the at least one sheet of rubber material, and then molding the sheets of rubber and floss material into the animal chew toy as recited in independent claim 1.

Sasson, Jr. discloses a method of stacking strips of flexible material into at least one stack of folded members. Sasson, Jr. discloses that in the rubber industry, the need arises wherein processed rubber is to be used in injection molding machines. If the rubber is to be used in an injection molding machine, it must be cut into narrow strips with a width of six inches or less. The Sasson, Jr. method is comprised of the steps of depositing the respective festoons into a stack of folded members, laying an initial flap of flexible material on a stacking surface, creating a first folded member by placing a first festoon on the initial flap of flexible material, and creating additional folded members by placing each festoon upon a preceding festoon. The result is a stack of at least one side where the folded members are aligned.

Sasson, Jr. does not disclose providing at least one sheet of rubber material formed in a general shape and size of the animal chew toy. Nor does Sasson, Jr. disclose placing a floss material comprised of at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy adjacent to the at least one sheet of rubber material and molding the sheets of rubber and floss material into the animal chew toy by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat. Instead, Sasson, Jr. only discloses a process for folding and stacking rubber sheets such that these can be cut into elongated strips of a very narrow width for introduction into an injection molding machine.

In summary, Denesuk, et al. discloses the creation of a matrix of material to create a degradable animal chew toy; Kamiura, et al. discloses a process for

producing clutch facings without asbestos; and Sasson, Jr. discloses a method of stacking strips of flexible material, such as rubber, for introduction into an injection molding machine. The teachings of Denesuk, Kamiura, and Sasson, Jr. are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clonetech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000).

Thus, the Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990).

Furthermore, the combined teachings of Denesuk, Kamiura, and Sasson, Jr. do not teach the claimed invention, as recited in amended independent claim 1. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". W.L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. Ruiz v. A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; In re Dembicza, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

Ecolochem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting In re Rouffett, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

In light of the foregoing remarks, Applicant believes that amended independent claim 1 is not rendered obvious by Denesuk, Kamiura, and Sasson, Jr. patents. Accordingly, Applicant respectfully submits that independent claim 1, and those claims depending therefrom, should be allowed.

Independent claim 14 recites a method for manufacturing an animal chew toy which is very similar to amended independent claim 1. Independent claim 14 specifically recites providing first and second layers of a tire rubber material cut into a general shape or size of the animal chew toy, and placing a floss material comprising a synthetic fiber mesh cut into the general shape or size of the animal chew toy between the first and second layers of rubber material. The first and second layers of rubber and floss material are compressed under pressure and

heat to mold the first and second layers of rubber and floss material into the animal chew toy. Claim 14 was rejected in the Office Action as being unpatentable over the same combination of references (Denesuk, Kamiura, and Sasson, Jr.) as that discussed above. For the same reasons discussed above, independent claim 14 is not rendered obvious by a combination of these non-analogous references. Even when improperly combined, they fail to disclose all of the recitations of independent claim 14. Accordingly, Applicant respectfully requests that the rejection be withdrawn, and independent claim 14, and those claims depending therefrom, be allowed.

Independent claim 21 has been amended, and is similar in most of its recitations to independent claims 1 and 14 in that at least one sheet of tire rubber material is provided cut into a general shape or size of the animal chew toy, a sheet of floss material comprising a nylon or polyester fiber mesh is cut into the general shape or size of the animal chew toy and placed adjacent to the at least one sheet of rubber material, and the sheets of rubber and floss material are compressed under pressure and heat to mold the rubber and floss material into the animal chew toy. However, independent claim 21 further recites that the rubber material is comprised of natural or synthetic rubber material mixed with carbon black. Independent claim 21 was rejected as being unpatentable under the combination of Denesuk, Kamiura, Sasson, Jr. and Willinger (U.S. Patent No. 6,622,659). The Willinger reference was added to this combination as it was admitted that the combination of Denesuk, Kamiura, and Sasson, Jr. do not teach a tire rubber material mixed with carbon black. The Office Action, on page 8, states that "Willinger ('659) teaches a pet chew toy made from a tire rubber material mixed with carbon black (see col. 6, lines 36-43)."

Willinger discloses the creation of spherical and spherical polyhedral skeletal animal toys from the various rubber materials. In column 6, Willinger does disclose a rubber reinforced with carbon black. However, there is no motivation to combine Willinger with either Sasson, Jr. Kamiura, et al. or Denesuk, other than the teachings of the present invention. The fact that rubber reinforced with carbon black has hot and cold tear resistance and resilience

qualities is of no consequence to the teachings of these three references. In fact, Denesuk discloses a degradable animal chew article which is intended to be broken when the article is chewed. In column 4, line 17-column 5, line 29, Denesuk discloses various classes of biodegradable polymers, which are typically starch-based resins, available for incorporation into its animal chew toy so as to have a degradable nature. This is in direct conflict with the teachings of Willinger of forming a tear-resistant spherical animal chew toy comprised of various rubbers, which may be reinforced with carbon black. Of course, as stated above, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Furthermore, using the claims as a frame in the prior references as a mosaic to piece together a facsimile of the claimed invention is impermissible hindsight. Accordingly, independent claim 21 is patentably distinct from the cited references, and should be allowed. For the same reasons, dependent claims 3, 4, and 15, which also recite the tire rubber material, should also be allowed.

Dependent claim 13 recites that the animal chew toy is of a tire configuration having a diameter of between six and ten inches, and does not include imbedded metal therein. The Examiner cites to Markham, et al. (U.S. Patent No. 4,802,444), and more particularly column 1, lines 10-16, which states "However, dog toys having ring-like and ball shapes are also sometimes seen in the marketplace." Applicant respectfully submits that this disclosure does not teach of an animal chew toy of a tire configuration having a diameter between six and ten inches without any metal embedded therein.

Applicant further submits that those references referred to in combination with the above-mentioned references fail to overcome the deficiencies of the combinations of references discussed above, the references are non-analogous to one another, and Applicant's invention has been improperly used as a shopping list to patch together these references in order to form rejections. Thus, these claims (3-5, 7-12, 16-20 and 22-25) should be allowed as well.

CONCLUSION

In light of the foregoing amendments and remarks, Applicant respectfully submits that the currently pending claims (1, 3-5, and 7-25) are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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